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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SCOTT EDWARD KLOPFENSTEIN

Appeal 2008-4739
Application 10/092,039
Technology Center 2400

Decided: February 24, 2009

Before KENNETH W. HAIRSTON, JOSEPH F. RUGGIERO, and
ROBERT E. NAPPI, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellant appeals under 35 U.S.C. § 134 from the Final Rejection of claims 1-16, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

Appellant's claimed invention relates to an electronic program guide for televisions which includes a scan list that identifies a plurality of program channels that are available for viewing. Upon a determination that a program channel is not included within the available for viewing scan list, the program guide information associated with that program channel is deleted from the program guide database. (Spec. 2:6-17).

Claim 1 is illustrative of the invention and reads as follows:

1. A method, comprising:

adapting the storage of program guide information for a plurality of programs in a receiver, wherein said adapting step includes:

determining whether a channel is included within a scan list comprising a plurality of channels available for viewing; and

deleting program guide information associated with said channel if said channel is not included within said scan list.

The Examiner relies on the following prior art references to show unpatentability:

Lazarus	US 5,652,613	Jul. 29, 1997
Duhault	US 5, 900,868	May 4, 1999

Claims 1, 4-6, 10, 11, and 13-16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Duhault.

Claims 2, 3, 7-9, and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Duhault in view of Lazarus.

Rather than reiterate the arguments of Appellant and the Examiner, reference is made to the Briefs and Answer for the respective details. Only

those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make in the Briefs have not been considered and are deemed to be waived [see 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

- (i) *Under 35 U.S.C. § 102(b), does Duhault have a disclosure which anticipates the invention set forth in claims 1, 4-6, 10, 11, and 13-16?*

The pivotal issue before us in making this determination is whether Appellant has demonstrated that the Examiner erred in finding that Duhault discloses the deletion of program information associated with a viewing channel based on a determination that a viewing channel is not included within a scan list of available viewing channels.

- (ii) *Under 35 U.S.C. § 103(a), with respect to appealed claims 2, 3, 7-9, and 12, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Duhault with Lazarus to render the claimed invention unpatentable?*

The pivotal issue before us in making this determination is whether Appellant has demonstrated the Examiner erred in determining the obviousness to the skilled artisan of modifying Duhault by adding the “housekeeping” program guide information deletion features of Lazarus.

FINDINGS OF FACT (FF)

The record supports the following findings of fact by a preponderance of the evidence:

1. Duhault discloses (Figure 1, col. 2, ll. 9-32) a system for displaying thumbnail images of a user's customized list of television viewing channels on a display.

2. Duhault further provides (Figure 5, col. 5, ll. 14-30) for the entering by a user of an edit selection for one of the displayed viewing channels. Upon detection of the entry of an edit selection, a set of optional viewing parameters is provided.

3. Duhault's disclosed (col. 5, ll. 30-34) optional viewing parameters can include the deletion of a viewing channel from the user's customized channel list as well as the addition or deletion of a channel from a parental control lock-out list.

4. Duhault also discloses (col. 5, ll. 34-43) that if a selection of an optional viewing parameter is detected, the selected parameter is executed upon the selected thumbnail.

5. Lazarus discloses (Figure 1, col. 2, ll. 44-64) a television electronic program guide (EPG) which includes a two-level memory "housekeeping" operation which functions to identify and delete obsolete program schedule information.

6. Lazarus further describes (col. 4, ll. 46-54) an electronic program guide "housekeeping" feature which suggests that a program record will not be deleted from the program guide list if other showings of the program are scheduled to be run on other channels in the future.

PRINCIPLES OF LAW

1. ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1458 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears

the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore, ““there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

35 U.S.C. § 102(b) REJECTION

Appellant’s arguments in response to the Examiner’s anticipation rejection, based on Duhault, of independent claims 1, 10, and 16 assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Duhault so as to establish a *prima facie* case of anticipation. Appellant’s arguments focus on the contention that, in contrast to the requirements of appealed independent claims 1, 10, and 16, Duhault does not disclose the deletion of program guide information associated with a channel if the channel is not included within a user’s scan list of available viewing channels. According to Appellant (App. Br. 12; Reply Br. 12), in the Figure 5 embodiment of Duhault referenced by the Examiner, a delete operation is performed only when an edit/select viewing parameter input is received from a user.

We do not agree with Appellant. We find no error in the Examiner's determination (Ans. 4, 7, and 8) that Duhault's disclosure (col. 5, ll. 14-43) of enabling a user to delete a selected channel from the user's customized channel list, i.e., scan list, by entering an edit/select input corresponds to the deleting operation set forth in each of the independent claims 1, 10, and 16. It is apparent to us that an ordinarily skilled artisan would recognize and appreciate that the logical end result of Duhault's disclosed channel deletion operation is a determination that when programming guide information for a user's customized channel list is to be displayed, the information for the deleted, or locked out, channel will not be displayed since the deleted channel is no longer in the user's customized channel list.

The rule that anticipation requires that every element of a claim appears in a single reference accommodates situations where the common knowledge of "technologies" is not recorded in a reference, i.e., where technical facts are known to those in the field of the invention. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1269 (Fed. Cir. 1991). Similarly, *In re Graves*, 69 F.3d 1147, 1152 (Fed. Cir. 1995) confirms the longstanding interpretation that the teachings of a reference may be taken in combination with knowledge of the skilled artisan to put the artisan in possession of the claimed invention within 35 U.S.C. § 102 even though the patent does not specifically disclose certain features.

In view of the above discussion, since Appellant has not demonstrated that the Examiner erred in finding that all of the claimed limitations are present in the disclosure of Duhault, the Examiner's 35 U.S.C. § 102(b) rejection of independent claims 1, 10, and 16, as well as dependent claims 4-6, 11, and 13-15, not separately argued by Appellant, is sustained.

35 U.S.C. § 103(a) REJECTION

We also sustain the Examiner's obviousness rejection of dependent claims 2, 3, 7-9, and 12 based on the combination of Duhault and Lazarus. The Lazarus reference discloses (col. 4, ll. 46-54) a "housekeeping" operation for an electronic program guide that functions to delete program records that are obsolete but will retain program records if the information is referenced by another channel, e.g., the showing of a particular program on another channel at another time. We find no error in the Examiner's line of reasoning (Ans. 4-6, 9, and 10) establishing a basis for modifying the disclosure of Duhault by adding the electronic programming guide "housekeeping" teachings of Lazarus to address the features of the rejected claims.

To whatever extent Appellant is suggesting (App. Br. 17-22; Reply Br. 17-22) that the Examiner's proposed combination of Duhault and Lazarus must fail since Lazarus does not provide a disclosure of determining the deletion of channels from a scan list, we find such contention to be without merit since the Examiner has relied upon Duhault for this teaching. It is apparent from the Examiner's line of reasoning in the Answer that the basis for the obviousness rejection is the combination of Duhault and Lazarus. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. *In re Keller*, 642 F. 2d 413, 425, (CCPA 1981); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, (Fed. Cir. 1986).

CONCLUSION

Based on the findings of facts and analysis above, we conclude that Appellant has not shown that the Examiner erred in rejecting claims 1, 4-6, 10, 11, and 13-16 for anticipation under 35 U.S.C. § 102(b), nor in rejecting claims 2, 3, 7-9, and 12 for obviousness under 35 U.S.C. § 103(a).

DECISION

The Examiner's decision rejecting claims 1, 4-6, 10, 11, and 13-16 under 35 U.S.C. § 102(b) and claims 2, 3, 7-9, and 12 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

gvw

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